

REMARKS/ARGUMENTS

Claims 1-22 are pending. Claims 1-7 and 20-22 are withdrawn from consideration. Claims 8, 9, and 15-19 are rejected. Claims 10-14 are objected to.

Applicants' Election and Preliminary Amendment of February 28, 2003 amended the left half of the structure having the 5-membered ring to recite "Y1" instead of "Y2", as commented by the Examiner at item 15 of the July 8, 2003 Office Action.

ELECTION

During a telephone conversation on June 26, 2003, the Examiner and applicants' undersigned representative discussed broadening the scope of the claims to be searched with a restriction to one of three groups of inventions: Group I (claims 1-7) drawn to compounds of Formula 3, Group II (claims 8-19) drawn to a method of performing a diagnostic procedure, and Group III (claims 8-15, 18, and 20-21) drawn to a method of performing a therapeutic procedure. Applicants thus elect with traverse Group II (claims 8-19), drawn to a method of performing a diagnostic procedure using compounds of formula 3 wherein, as set forth in the Supplemental Election dated June 9, 2003, W₁ and W₂ are -CR¹⁰R¹¹; Y₁, Y₂, Z₁, and Z₂ are -(CH₂)_a-CONH-Bm; X₁ and X₂ are nitrogen; Q is -O-; K₁ and K₂ are -CH₂; R₁ to R₉ are hydrogen; R₁₀ and R₁₁ are -C(CH₃)₂; A₁ is a single bond; and A₁, B₁, C₁, and D₁, form a six membered carbocyclic ring.

Applicants affirm the new Election made during the telephone conversation on June 26, 2003 with traverse. Applicants respectfully assert that such a restriction is improper for the same reasons and support analysis as stated in the

original Election and Preliminary Amendment dated February 28, 2003. Briefly, claims 1-7 recite a compound, and claims 8-22 recite a method of performing a diagnostic and therapeutic procedure by administering the composition of formula 3. Indeed, this combination is reflected even in the title: Carbocyanine Dyes for Tandem Photodiagnostic and Therapeutic Applications. Additionally, applicants note that all the claims are directed to the structure designated as formula 3.

For the reasons discussed, applicants respectfully request that the Examiner reconsider the restriction requirement.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 8, 9, and 15-19 are rejected under 35 U.S.C. § 103(a) as obvious over Licha, and also as obvious over Turner.

Applicants believe that the basis of the Examiner's rejection is as follows, but request that the Examiner contact the undersigned representative if their understanding is incorrect.

The Examiner finds that neither Licha nor Turner disclose the complete structure (formula III), but disclose a part of structure, and that it would be obvious for one skilled in the art to include other components to the core structure of either Licha or Turner to arrive at applicants' invention.

Applicants respectfully disagree. The claimed method of diagnosis administers the compound of formula III. Formula III has three components: (1) a targeting component, (2) a phototherapy component, and (3) a photodiagnostic component (page 4, line 21 to page 5, line 1; page 11, lines 1-5). The Examiner's

r striction artificially separated applicants' invention of performing a tandem diagnostic and therapeutic procedure by administering formula III.

Applicants original Election was with traverse. While applicants affirm the new Election indicated by the Examiner at page 5 of the July 8, 2003 Office Action, applicants maintain their traverse because applicants do not change their basic invention, yet this Election requires choosing between phototherapy by administering formula III and photodiagnosis by administering formula III, when the invention is for combined phototherapy and photodiagnosis. Indeed, this combination is reflected even in the title: Carbocyanine Dyes for Tandem Photodiagnostic and Therapeutic Applications.

Applicants respectfully assert that the Examiner cannot now use the restriction to further determine that substituent groups of formula III are only obvious variations. In administering the compound of formula III for a method of diagnosis (the claims elected responsive to the Examiner's new restriction), the entire compound of formula III is administered. Formula III is not rendered obvious over either of Licha or Turner for at least the following reason.

Licha discloses compounds as contrast media for diagnosis (abstract). Turner discloses compounds for *in vivo* and *in vitro* diagnosis of neurodegenerative diseases; with Turner's components A and B limited to beta-amyloid plaque binders. The Examiner has not established a *prima facie* case of obviousness by showing where Licha or Turner teach, suggest, or motivate including components such that the compound administered for a diagnostic procedure contains applicants' formula III components for targeting and tandem phototherapy and photodiagnosis.

In addition, claim 22 is properly directed to the elected claims because it recites detection as well as treatment of micrometastases.

Thus, applicants respectfully request that the rejection be withdrawn.

CONCLUSION

For the foregoing reasons, applicants submit that all of the claims are patentable, and an early Notice of Allowance is respectfully requested. Applicants know of no fee due with this submission. However, if any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to Deposit Account No. 23-3000.

The Examiner is invited to contact applicants' undersigned representative with any questions.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

Beverly A. Lyman
Beverly A. Lyman, Ph.D.
Reg. No. 41,961

2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202
513-241-2324
513-421-7269 - Facsimile
K:MRD\74\AMD.wpd

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